

PATENT APPLICATION
Attorney Docket No.: TRV03-0001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF)	
Dennis R. Berman)	Examiner: Gishnock, Nikolai A.
Application No.: 10/613,564)	Group Art Unit: 3714
Filing Date: July 02, 2003)	Confirmation Number: 5486
Title: METHOD AND SYSTEM FOR LEARNING)	
KEYWORD BASED MATERIALS)	

SUBMITTAL OF MATERIALS FROM CO-PENDING APPLICATIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Recently, the Federal Circuit, in *McKesson Information Solutions, Inc., v. Bridge Medical, Inc.* (2005-1517) affirmed a District Court's determination that a patent was unenforceable due to inequitable conduct. The inequitable conduct was based upon a patent attorney's nondisclosure of office actions from co-pending applications.

In light of *McKesson*, I have attached an office action from a co-pending application of the present application. You may or may not find this office action to be material to the present application.

Respectfully submitted,



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Registration No. 41752

Date: February 20, 2008

<p>Address correspondence to:</p> <p><input checked="checked" type="checkbox"/> <i>Customer Number or Bar Code Label</i></p> <p>28422</p>	<p>or</p> <p><input type="checkbox"/> <i>Correspondence Address Below</i></p> <p>Park, Vaughan & Fleming L.L.P. P.O. Box 140678 Boise, ID 83714</p>	<p>Direct telephone calls to:</p> <p>Hoyt A. Fleming III (208) 336-5237</p>
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/055,306	02/09/2005	Dennis R. Berman	TRV03-0001-3	1500

28422 7590 01/25/2008
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EXAMINER

UTAMA, ROBERT J

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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01/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

11/055,306

Applicant(s)

BERMAN, DENNIS R.

Examiner

Robert J. Utama

Art Unit

3714

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2007.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-44 and 50-59 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 40-44 and 50-59 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 01/11/2008, 10/26/2007.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is a response to the amendment filed on 10/26/2007. The current status of claim are as follow: Claim 40-44 and 50-59 are still pending and claim 1-39, 45-49 have been cancelled.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claim 40-42 rejected under 35 U.S.C. 102(b) as being anticipated by Robinson US 2003/0031996.**

Claim 40: The Robinson reference provides a teaching of a computer system configured to provide training to the users, the computer system is comprised of: a program storage device that includes a database (see FIG. 1 item 1040) that stores a question (see paragraph 50) and answer to the question that includes at least one keyword and non-keyword (see FIG 7b item 294), the database also separately stores the at least one non-keyword in a column in the database so that the at least one keyword of the answer is stored in the database in two location, the column not storing the at least one non-keyword of the answer (see FIG 7A item 293 see paragraph 50 and 63). The program devices also includes computer readable medium that when executed by the system provides training to at least one user utilizing the question, answer to the question and separately stored one keyword fo the answer (see paragraph 64-69). The computer readable medium contain instruction when executed by the computer system provides training that distinguish the at least one non-keyword of the answer from the at least one non-keyword of the answer (see FIG 7A item 293, 7B item 294 and paragraph 67-68).

The Robinson reference does not provide an explicit teaching where the question, answer to the question and separately stored at least one keyword of the answer are stored in a separate database column. However, it would have been inherent that different data types be stored in a separate column of the database.

Claim 41: The Robinson reference provides a teaching where the question, answer to the question and the separately stored at least one keyword of the answer is stored in a database table (see paragraph 30-35). While the Robinson reference does not mention the word database table. It would have been inherent that data in a relational database be stored in a database table.

Claim 42: The Robinson reference provides a teaching where the question, answer to the question and the separately stored at least one keyword of the answer is stored in a database column (see paragraph 30-35). The Robinson reference does not provide an explicit teaching where the question, answer to the question and separately stored at least one keyword of the answer are stored in a separate database column. However, it would have been inherent that different data types be stored in a separate column of the database.

Claim 44: The Robinson reference also provides a teaching of a database table that stores a question title and wherein the program storage includes computer readable instruction that when executed by the computer system provides training to at least one user utilizing the question title (see FIG 7 item "AP Subject" or "outline topics").

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 43 rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson US 2003/0031996 in view of Sugimoto US 6,755,661 (hereinafter Sugimoto '661).

Robinson fails to explicitly teach of using or storing question number in the database table and of utilizing the question number to provide training. Sugimoto '661 provides a teaching of storing and using question number -along with other attributes related to a particular question- to provide training to at least one user (Sugimoto '661 Col.6:9). Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art to incorporate storing the storing of question number into Robinson database, in light of Sugimoto '661 teaching. One of ordinary skilled in the art would have been motivated to make this combination in order to help the student identify (along certain related attributes) which question have been answered incorrectly.

6. Claim 51 and 57-59 rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson US 2003/0031996 and further in view of Boon 6,022,221.

Claim 51: Robinson fails to provide a teaching a database that stores data and computer readable medium that indicates whether the user is taking Introductory or Retention round of training. However, Boon '221 discloses wherein the database stores data indicating whether a user is taking an Introductory round (i.e., EASY display mode) of training or a Retention round (i.e., reviews) of training, and wherein the program storage device includes computer-readable instructions that when executed by the computer system utilize the data indicating whether a user is taking an Introductory round of training or a Retention round of training (Col.4: 46-48 and Col.5: 18-23). Boon '221 also explains how the data taken during the Introductory (or EASY mode) is used to help train the user (Col.9:26-39). Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of teaching a database that stores data and computer readable medium that indicates whether the user is taking Introductory or

Retention round of training, as taught by Boon '221, because it would enable the system to effectively introduce new material that is relevant the subject into a user's short and long time memory (see col. 2:57-65).

Claim 57-59: Robinson fails to provide a teaching where the database stores the data and computer readable instruction that indicates the round number where a user successfully answer a question without a hint in the round [**Claim 57**], two times without a hint in the round [**Claim 58**] and X times without a hint in the round where X is an integer greater than 2 [**Claim 59**]. However, Boon '221 et al provides a teaching of a database stores the data and computer readable instruction that indicates the round number where a user successfully answer a question without a hint in the round [**Claim 57**], two times without a hint in the round [**Claim 58**] and X times without a hint in the round where X is an integer greater than 2 [**Claim 59**] (see Boon '221 col. 7:60-8:10). Therefore, it would have obvious to one of ordinary skilled in to include the feature of database stores the data and computer readable instruction that indicates the round number where a user successfully answer a question without a hint in the round, two times without a hint in the round and X times without a hint in the round where X is an integer greater than 2, as taught by Boon, because it would enable the system to pinpoint mistakes in a user's understanding (see col. 5:50-60).

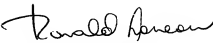
7. Claim 52-55 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson US 2003/0031996 and further in view of Cook 5,727,950.

Claim 52-55: Robinson fails to provide a teaching of database that stores data and computer readable instruction that indicates the number of retries by a user in an Introductory round of training (**Claim 52**), the number of retries by a user in a Retention round of training (**Claim 53**), utilizing the number of retries in the Introductory Round to determine the relative difficulty (**Claim 54**) and utilizing the number of retries in the Retention Round to determine the relative difficulty (**Claim 55**). However, Cook 950 provides a teaching of

database that stores data and computer readable instruction that indicates the number of retries by a user in an Introductory round of training, the number of retries by a user in an Retention round of training, and utilizing the number of retries in order to determine the relative difficulty (see Cook '950 col. 49:10-20). Therefore, it would have been obvious to include the feature a database that stores data and computer readable instruction that indicates the number of retries by a user in an Introductory round of training, the number of retries by a user in an Retention round of training, and utilizing the number of retries in order to determine the relative difficulty, as taught by Cook '950, in order to individualized the teaching material to the level of a user's performance (see col. 49:30-42).

Claim 56: Robinson fails to provide a teaching of database that stores data and computer readable instruction that indicates the number of times a user utilizes the hint to answer the question. However, Cook 950 provides a teaching a teaching of database that stores data and computer readable instruction that indicates the number of times a user utilizes the hint to answer the question (see Cook '950 col. 49:10-20). Therefore, it would have been obvious to include the feature a database that stores data and computer readable instruction that indicates the number of retries by a user in an Introductory round of training, the number of retries by a user in an Retention round of training, and utilizing the number of retries in order to determine the relative difficulty, as taught by Cook '950, in order to individualized the teaching material to the level of a user's performance (see col. 49:30-42).

8.


RONALD LANEAU
PRIMARY EXAMINER
1/22/08